



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Anthony Nicholls Art Unit : 1631
Serial No. : 09/644,937 Examiner : John S. Brusca
Filed : August 23, 2000 Confirmation no. : 1945
Title : METHOD FOR DETERMINING A SHAPE SPACE FOR A SET OF
MOLECULES USING MINIMAL METRIC DISTANCES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705(b)**

Applicant hereby requests reconsideration of the Patent Term Adjustment of the above-identified U.S. Patent Application under 37 C.F.R. § 1.705(b). Under § 1.705(b) Applicant may request reconsideration of Patent Term Adjustment (PTA) on or before payment of the issue fee, if Applicant believes that the amount of PTA indicated on form PTOL-85 ("Determination of Patent Term Adjustment under 35 U.S.C. § 154(b)") accompanying the Notice of Allowance is in error.

In the instant application, the Form PTOL-85 mailed November 4, 2005 states that the total PTA at Allowance is 194 days. Because Applicant believes that the correct number should be 511 days, Applicant hereby requests reconsideration of the PTA accorded the above-identified patent application for the reasons discussed hereinbelow.

The Commissioner is hereby authorized to charge Applicant's Deposit Account No. 06-1050 for \$200 to cover the fee for this petition in accordance with 37 C.F.R. § 1.705(b)(1).

The Issue Fee Transmittal, along with payment, for the above-referenced application is also being filed on even date herewith to Mail Stop Issue Fee.

02/07/2006 TBESHAH2 00000054 061050 09644937

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CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EV 583 597 185 US

FEBRUARY 1, 2006
Date of Deposit

Statement of Facts

The Form PTOL-85 mailed November 4, 2005, stated that the Patent Term Adjustment (PTA) would be 194 days. Applicant has checked the file history of the instant application and has also reviewed the "Patent Term Adjustment History" on the Patent Application Information and Retrieval (PAIR) section of the U.S. Patent and Trademark Office's (PTO) web-site.

The Patent Term Adjustment History in the PAIR system reflects that the PTO calculated the PTA as follows:

(1) A PTO First Action was due October 23, 2001 (14-Months from the initial application filing date of August 23, 2000). The PTO mailed a Restriction Requirement May 21, 2002. Applicant agrees with the PTO's calculation of a PTO delay of 210 days;

(2) Applicant's Response to Non-final Action mailed September 10, 2002 was due at the three-month date, December 10, 2002. Applicant filed a Response after Non-Final Action on March 10, 2003 ("The March 10, 2003 Response"). The PTO accorded this response a date of March 11, 2003. Applicant mailed a communication date July 11, 2003 requesting correction of the date accorded the March 10, 2003 Response, and providing evidence via Express Mail receipt that the response was filed on March 10, 2003. Therefore, Applicant disagrees with the PTO's calculation of Applicant's delay as 91 days; Applicant believes that delay attributable to Applicant is instead only 90 days.

(3) PTO subsequently mailed a Notice of Informal or Non-Responsive Amendment on June 30, 2003 ("The June 30, 2003 Notice") in which the PTO designated Applicant's March 10, 2003 Response to be "non-responsive" for failing to provide a Substitute Abstract on a separate sheet. However, Applicant's March 10, 2003 Response references an attached Substitute Abstract (item (c) on page 1). Thus it is unclear whether the attached Substitute Abstract was not supplied by Applicant, as alleged by the PTO, or whether it was lost by the PTO upon receipt. Even assuming that the attached Abstract was in fact not supplied by Applicant, Applicant disagrees that the additional delay of 132 days should be attributed to Applicant for the following reasons. The June 30, 2003 Notice acknowledges that Applicant's March 10, 2003 Response was "*bona fide*." The June 30, 2003 Notice further acknowledges that the March 10, 2003

Response had supplied a Substitute Abstract, though not on a separate sheet of paper. Thus, the information necessary for the Examiner to examine Applicant's March 10, 2003 Response was not omitted. By requesting compliance, the PTO itself unnecessarily delayed examination of Applicant's application, to detriment of Applicant. Furthermore, Applicant questions why the Office took as long as a 111 days (from March 10, to June 30, 2003) to issue a Notice requiring compliance with non-substantive matters when such alleged-non-compliance could have been easily determined by an initial review of Applicant's response upon receipt by junior member of staff. Applicant respectfully submits that it did not require an Examiner's review to determine the alleged noncompliance.

Accordingly, Applicant disagrees with the PTO's attribution of 132 days of delay to Applicant, and respectfully submits that such delay be attributed instead to the Office. Applicant respectfully points out that Applicant's swift compliance with the June 30, 2003 Notice, to which Applicant filed a response on July 21, 2003, be taken into consideration as evidence of Applicant's earnest efforts to advance prosecution of the Application. This is particularly poignant in view of the fact that the PTO unaccountably then took a further 9 months to issue a subsequent office action. In summary, Applicant believes that a further delay of 133 days (taking into account a corrected mailing date for Applicant's March 10, 2003 response) is attributable to the Office.

(4) A PTO Action was due November 21, 2003, 4-Months after Applicant's July 21, 2003 Response after Non-Final Action. The PTO mailed a Final Rejection on May 19, 2004. Applicant agrees with the PTO's attribution of delay to the PTO of 180 days.

(5) Applicant's response to the PTO's Final Rejection of May 19, 2004, was due at the three-month date, August 19, 2004. Applicant filed a Request for Continued Examination on September 20, 2004. Applicant agrees with the PTO's determination of delay attributable to Applicant of 32 days.

(6) A PTO Action was due July 17, 2005, 4 Months from Applicant's response to non-final action on March 17, 2005. The PTO mailed a Notice of Allowance on September 14,

2005 and a PTO Delay of 59 days was accorded. Applicant agrees that at least 59 days are attributable to the PTO in this regard.

Applicant filed an Information Disclosure Statement on October 11, 2005 that contained only references that had come to Applicant's attention less than 30 days prior to filing the Information Disclosure Statement. Thus, under 37 C.F.R. § 1.704(d), no correction of Patent Term Adjustment is warranted by this filing.

Upon review of the Notice of Allowance mailed September 14, 2005, Applicant noticed that claims 23-26 had been improperly cancelled by the Examiner. Accordingly, Applicant's undersigned representative, Richard G. A. Bone, discussed this matter with Examiner John S. Brusca by telephone, on October 12, 2005, less than 30 days after the mailing of the Notice of Allowance, and requested reinstatement of the claims.

The Examiner issued a *Corrected* Notice of Allowance and accompanying Examiner's amendment that reinstated the improperly cancelled claims on November 4, 2005. The Corrected Notice of Allowance also contained a new mail date re-starting the period of time for payment of issue fee. The difference between the Office's mailing of the Notice of Allowance of September 14, 2005 and the Office's mailing of the Corrected Notice of Allowance of November 4, 2005 is 51 days. Since the requirement for a corrected notice of allowance was due to PTO error, the total PTO delay for the mailing of a Notice of Allowance should total 110 days (*i.e.*, 59 + 51 days) rather than 59 days.

Summary

In consideration of the above-described events, Applicant respectfully requests that PTA be recalculated as follows:

- PTO Delay be increased from 449 days to 633 days (representing additional contributions of 51 and 133 days);
- Applicant's delay be decreased from 255 days to 122 days (representing reductions of 1 day and 132 days); and
- Total PTA be therefore increased from 194 days to 511 days.

Concluding Remarks

Applicant respectfully requests correction of the PTA, under the provisions of 37 C.F.R. § 1.705, to 511 days.

Under the provisions of 37 C.F.R. § 1.705(b), Applicant timely submits this request for reconsideration of PTA concurrently with payment of the issue fee.

Applicant asserts, as required by 37 C.F.R. § 1.705(b)(2)(iii), that the subject U.S. patent application is not subject to a terminal disclaimer.

Applicant further asserts, as required by 37 C.F.R. § 1.705(b)(2)(iv)(B), that they did not fail to engage in reasonable efforts to conclude processing and examination of the application, except where delays attributable to Applicant are acknowledged herein.

As stipulated by 37 C.F.R. § 1.704(e), the instant request for reconsideration of Patent Term Adjustment under 37 C.F.R. §§ 1.705(b,c), is not to be considered a failure to engage in reasonable efforts to conclude prosecution of the application, under 37 C.F.R. § 1.704(c)(10).

Fee Authorization

Applicant believes that the error in calculation of patent term adjustment was a result of PTO error, and, therefore, that no fee should be levied in respect of the instant request. Nevertheless, should it be determined that such a fee is owed, and in compliance with 37 C.F.R. § 1.705(b)(1), Applicant hereby authorizes payment of the fee of \$200.00, under 37 C.F.R. § 1.18(e) from deposit account number 06-1050 (order no. 19455-002001). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: _____

February 15th, 2006

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